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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,494	05/30/2006	Chieko Kitada	63628 (46342)	8374
21874 7590 02/11/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			EXAMINER BRADLEY, CHRISTINA	
			ART UNIT 1654	PAPER NUMBER
			MAIL DATE 02/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/540,494	Applicant(s) KITADA ET AL.	
	Examiner Christina Marchetti Bradley	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-15 and 38-41, drawn to metastatin derivatives.

Group II, claim(s) 16, 17, 27 and 28, drawn to a method of treating cancer.

Group III, claim(s) 18, 19, 29, 30, 42, 44, 45 and 47, drawn to methods of regulating the pancreas or treating pancreatic disease.

Group IV, claim(s) 20 and 31, drawn to a method of regulating the placenta.

Group V, claim(s) 21 and 32, drawn to a method for treating choriocarcinoma.

Group VI, claim(s) 21 and 32, drawn to a method for treating hydatid mole.

Group VII, claim(s) 21 and 32, drawn to a method for treating invasive mole.

Group VIII, claim(s) 21 and 32, drawn to a method for treating miscarriage.

Group IX, claim(s) 21 and 32, drawn to a method for treating fetal hypoplasia.

Group X, claim(s) 21, 32, 44 and 47, drawn to a method for treating abnormal glucose metabolism, type II diabetes, hypoglycemia, diabetic neuropathy, diabetic nephropathy, diabetic retinopathy, insulin resistance, unstable diabetes, insulin allergy, and insulinoma.

Group XI, claim(s) 21, 32, 44 and 47, drawn to a method for treating abnormal lipid metabolism, fatty atrophy, hyperlipemia and lipotoxicity.

Group XII, claim(s) 21 and 32, drawn to a method for treating labor induction.

Group XIII, claim(s) 22 and 33, drawn to a method for improving gonadal function.

Group XIV, claim(s) 23 and 34, drawn to a method for treating hormone-dependent cancer.

Group XV, claim(s) 23 and 34, drawn to a method for treating infertility.

Group XVI, claim(s) 23 and 34, drawn to a method for treating endometriosis.

Group XVII, claim(s) 23 and 34, drawn to a method for treating myoma of the uterus.

Group XVIII, claim(s) 24 and 35, drawn to a method for inducing or stimulating ovulation.

Group XIX, claim(s) 25 and 36, drawn to a method for promoting gonadotropic hormone secretion.

Group XX, claim(s) 25 and 36, drawn to a method for promoting sex hormone secretion.

Group XXI, claim(s) 26 and 37, drawn to a method for treating Alzheimer's disease.

Group XXII, claim(s) 26 and 37, drawn to a method for treating moderate cognitive impairment.

Group XXIII, claim(s) 42, 44, 46 and 47, drawn to a method for promoting urine formation and treating urinary disturbances.

Group XXIV, claim(s) 44 and 47, drawn to a method for treating hypertension.

Group XXV, claim(s) 44 and 47, drawn to a method for treating edema.

Group XXVI, claim(s) 44 and 47, drawn to a method for treating arteriosclerosis.

The inventions listed as Groups I-XXVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: metastatin derivatives are known in the prior art (see Figure 1 in Stafford *et al.*, *Cancer Research*, **2002**, 62, 5399-5404). Therefore, unity of invention is broken *a posteriori*.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: compounds 141, 174, 260, 269, 279, 286, 296, 300, 303, 305, 318, 319, 322, 323, 385 and 386.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1-47.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The species have different chemical structures.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Marchetti Bradley whose telephone number is (571) 272-9044. The examiner can normally be reached on Monday, Tuesday and Thursday, 8 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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